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10/009,398	03/13/2002	Alain Rahyer	136.165	1764

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EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/009,398

Applicant(s)

RAHYER ET AL.

Examiner

Walter F Briney III

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 11 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 23 April 1999. It is noted, however, that applicant has not filed a certified copy of the 99/05202 application as required by 35 U.S.C. 119(b).

### *Claim Objections*

Claim 14 is objected to because of the following informalities: Claim 14 claims dependence from itself. Appropriate correction is required. For the purpose of this examination claim 14 is assumed to depend from claim 12.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 7, 9, 10, 11, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "**the inductors and the capacitor**" in lines 3-4 of the claim. Claim 7 recites the limitation "**the capacitor**" in line 4 of the claim. Claim 11 recites the limitation "**the other two capacitors**" in line 6 of the claim. Claim 9 recites the limitation "**the first**" in line 6 of the claim. Claim 13 recites the limitation "**the lead**" in line 4 of the claim. There is insufficient antecedent basis for these limitations. For

the purpose of this action the examiner assumes that each definite article should be replaced with the appropriate indefinite article.

Claim 10 recites the limitation "**said means**" in line 5 of the claim. It is not clear whether this refers to the isolation or filter means. For the purpose of this examination the examiner assumes that "**said means**" refers to "**said isolation means.**"

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9, 10, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart (US Patent 3,860,757).

Claim 1 is limited to **a filtering device for a narrow-band terminal in a private installation**. The limitation "**connected to an access network carrying narrow-band services and broadband services**" is an intended use and carries no patentable weight. Stewart discloses **low-pass filtering means** (figure 4, elements 37, 38, 39, 40, 44, 45) and **isolation means comprising Zener diodes in opposite orientations and disposed in series** (figure 4, element 29, 49, 33, 53) (column 6, lines 22-28), **enabling the device to have a high input impedance isolating it from the installation when the narrow-band terminal is in the on-hook state** (abstract). Stewart's device must pass ringing signals to a party to allow proper telephone operation. Since the current

drawn during off-hook closes the isolation circuits, a high-voltage ringing signal will pass through the isolators (i.e. **whilst allowing the ringing signal to pass**) (column 2, lines 20-30). Therefore, Stewart anticipates all limitations of the claim.

Claim 2 is limited to **a filtering device according to claim 1**, as covered by Stewart. Stewart discloses **low-pass filters** (figure 4, elements 37, 38, 39, 40, 44, 45). Therefore, Stewart anticipates all limitations of the claim.

Claim 3 is limited to **a filtering device according to claim 1**, as covered by Stewart. Stewart discloses **a filter of the LC type** (figure 4, elements 37, 38, 39) **and in that the isolation means are placed at the inputs of the said filter** (figure 4, elements 29, 49, 33, 53). Therefore, Stewart anticipates all limitations of the claim.

Claim 5 is limited to **a filtering device according to claim 1**, as covered by Stewart. Stewart discloses **filtering** (figure 4, elements 37, 38, 39, 40, 44, 45) **and isolation means** (figure 4, elements 29, 49, 33, 53) **that are functionally distinct**. Therefore, Stewart anticipates all limitations of the claim.

Claim 9 is limited to **a filtering device according to claim 1**, as covered by Stewart. Stewart discloses **a second-order LC filter of high impedance** (figure 4, elements 37, 38, 39), **placed at the input of the device on the private installation side** (figure 1, element 15B, 16B) **and a second filter** (figure 4, elements 40, 44, 45) **coupled to the first, whose activation depends directly on the isolation means** (figure 4, elements 29, 49, 33, 53) (abstract). Therefore, Stewart anticipates all limitations of the claim.

Claim 10 is limited to a **filtering device according to claim 9**, as covered by Stewart. Stewart discloses **that the second filter includes a capacitor (figure 4, element 40) in parallel to the capacitor of the LC filter (figure 4, element 37) placed in the isolation means or after the said means**. Therefore, Stewart anticipates all limitations of the claim.

Claim 12 is limited to a **private installation**. Stewart discloses **at least one narrow-band terminal (figure 1, element 16A,B) and at least one broadband terminal (figure 1, element 26), connected to an access network carrying narrow-band services and broadband services (figure 1, see To Central Office), characterized in that it includes at least one filtering device (figure 1, element 15B, and figure 4) according to one of the preceding claims**. Therefore, Stewart anticipates all limitations of the claim.

Claim 13 is limited to a **private installation according to claim 12**, as covered by Stewart. Stewart discloses **that the device (figure 1, element 15B) is placed at the input of the narrow-band terminal (figure 1, element 16B) on the network access or on the lead connecting the terminal to the network (figure 1, elements 11, 12)**. Therefore, Stewart anticipates all limitations of the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart in view of Williamson (US Patent 6,477,249).

Claim 4 is limited to **a filtering device according to claim 1**, as covered by Stewart. Stewart discloses **a filter of the LC type** (figure 4, elements 37, 38, 39). The isolation means of Stewart are placed at the input of the filter. Therefore, Stewart anticipates all limitations of the claim with the exception **in that the isolation means are placed between the inductors and the capacitor of the said filter**. Williamson teaches to place an isolator (figure 12, element SW) between an inductor (figure 12, element RL) and capacitor (figure 12, element C2) in a low-pass filter for a private installation using DSL for the purpose of changing the filter's frequency response in the presence of signaling tones (column 2, line 66-column 3, line 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a higher order filter in the presence of tone signals as taught by Williamson for the purpose of using a high-order filter only when needed, thus providing a better impedance match for different conditions, and also enabling a customer to use DSL.

Claim 6 is limited to **a filtering device according to claim 1**, as covered by Stewart. For the same reasons as in claim 4 it would have been obvious to include the isolation means as taught by Williamson. The filter and isolator as taught by Williamson **are functionally interlinked** (figure 12, element SW, C2). Therefore, Stewart in view of Williamson makes obvious all limitations of the claim.

Claim 7 is limited to a **filtering device according to claim 6**, as covered by Stewart in view of Williamson. Williamson discloses a **relay controlling the bringing into service of the capacitor in the filter** (figure 12, element SW). Therefore, Stewart in view of Williamson makes obvious all limitations of the claim.

Claim 8 is limited to a **filtering device according to claim 6**, as covered by Stewart in view of Williamson. Stewart discloses a **second-order LC filter** (figure 4, elements 37, 38, 39) **and in that the isolation means** (Stewart, figure 4, elements 29, 49, 33, 53) (Williamson, figure 12, element SW) **are placed on each side of the capacitor** (Stewart, figure 4, element 37 corresponding to Williamson, figure 12, element C2) **of the said filter and in that it also comprises at least two other capacitors** (Stewart, figure 4, elements 30, 34) **each being placed in parallel to the assembly formed by the isolation means and the capacitor of the filter**. Therefore, Stewart in view of Williamson makes obvious all limitations of the claim.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart.

Claim 14 is limited to a **private installation according to claim 12**, as covered by Stewart. Stewart discloses placing the device on the input of the device, and associates a filter with each terminal, which means that a filter is included between a drop and a narrow-band terminal. Therefore, Stewart anticipates all limitations of the claim with the exception wherein the filter is **in the narrow-band terminal**. The examiner takes Official Notice of the fact that line filters installed in a terminal are well-known. It would have been obvious to one of ordinary skill in the art to place the line



filter of Stewart in the narrow-band terminal for the purpose of correctly terminating the impedance of each separate party line telephone at a terminal location.

### ***Allowable Subject Matter***

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if rewritten to overcome the 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections of indefiniteness.

Claim 11 is essentially the same as claim 8, as covered by Stewart in view of Williamson. However, the further limitation wherein **"the isolation means are placed after the capacitor of the LC filter"** is not clearly made obvious by Stewart in view of Williamson. Stewart includes an isolation device at the input of the low-pass filter. Therefore, claim 11 is allowable.

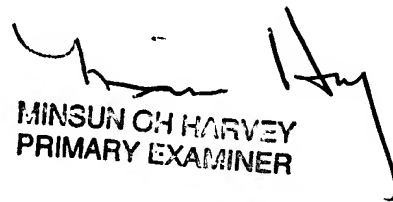
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F Briney III whose telephone number is 703-305-0347. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB  
3/22/04

  
MINSUN CH HARVEY  
PRIMARY EXAMINER